

## **REMARKS**

The following are applicant's response to issues raised in the Office Action.

Claims 1-12, 15, 16, 18 and 19 are pending. Claims 1, 3-4 and 18-19 have been amended. Applicants respectfully request entry of this amendment in order to move the instant application toward allowance or alternatively, to place the application in better form for appeal.

### **Rejection under 35 USC 103**

Claims 1 and 3-6 were rejected under 35 USC 103a over Seffernick (U.S. patent no. 5,966,117) in view of Amano (U.S. patent no. 6,241,684).

None of the cited references teach, disclose or suggest either alone or in combination, as in amended claim 1, a cursor control mechanism that has a shaft with a top and a bottom. A piezo-electric material is mounted on a semi-rigid substrate and is coupled to the bottom of the shaft.

While, Seffernick does disclose a z-axis output cursor control device, nether Seffernick nor show a piezo-electric material mounted on a semi-rigid substrate and coupled to the bottom of the shaft.

There is no basis for making the suggested combination. As the court of Appeals for the Federal Circuit has set forth, even if a prior art reference could be modified to construct an applicant's invention, the modification is not obvious unless there is a suggestion in the prior art. *In re Laskowski*, 10 USPQ2d 1397, 1398 (Fed. Cir. 1989). There is no suggestion to modify Seffernick to include a piezo-electric material to cause the cursor control mechanism to vibrate.

Dependent claims 3-9 depend from independent claim 1 and add additional patentable features and are allowable therewith.

Claims 10-11 and 15-16 were rejected under 35 USC 103a over Barber (U.S. patent no. 5,973,670) in view of Seffernick (U.S. patent no. 5,966,117) and further in view of Amano (U.S. patent no. 6,241,684).

None of the cited references teach, disclose or suggest either alone or in combination, as in claim 10, a computer input system that includes software for determining a condition that requires tactile feedback and provides a predefined electrical signal to the piezo-electric material in the cursor control device. The software further adapted to cause the piezo-electric material to vibrate for a predetermined period of time.

While, Barber discloses activating a tactile generator when a cursor moves over a certain object. It does not disclose vibrating the piezoelectric material for a pre-determined time.

If the combination of Barber and Seffernick was made, it would fail to activate the piezoelectric material for a pre-determined period of time.

There is no basis for making the suggested combination. There must be a showing of some objective teaching in the prior art or that knowledge generally available to one of ordinary in  
5 the skill of the art would lead that individual to combine the relevant teachings of the references. *In Re Fine*, 837 F2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed Cir 1988) (citing *In Re Lahu*, 747 F2d 703, 705, 223 USPQ 1257, 1258 (Fed Cir 1988). A rejection based on §103 must rest on a factual basis, with the facts being interpreted without hindsight reconstruction of the invention from the prior art. In making this evaluation, there is an initial burden of supplying the factual basis for  
10 the rejection advanced. One may not, because of doubt that the invention is patentable, resort to speculation, unfound assumption or hindsight reconstruction to supply deficiencies in the factual basis. See *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967).

Dependent claims 11-12 and 15-16 depend from independent claim 10 and add additional patentable features and are allowable therewith.

Claims 18 and 19 were rejected under 35 USC 103a over Seffernick (U.S. patent no. 5,966,117) in view of Amano (U.S. patent no. 6,241,684) and Culler (U.S. patent no. 6,545,666).

None of the cited references teach, disclose or suggest either alone or in combination, as in amended claims 18 and 19, a tactile feedback for a cursor control device that includes a cursor control device that has a top and bottom. The top of the cursor control device is adapted to be touched by a user. A piezo-electric assembly is mechanically coupled to the bottom of the cursor control device to deliver the vibrations to the user.

If the proposed combination of references were made, it would still fail to have a piezo-electric assembly that is mechanically coupled to the bottom of the cursor control device.

There is no basis for making the suggested combination. As the court of Appeals for the Federal Circuit has set forth, even if a prior art reference could be modified to construct an applicant's invention, the modification is not obvious unless there is a suggestion in the prior art. *In re Laskowski*, 10 USPQ2d 1397, 1398 (Fed. Cir. 1989). There is no suggestion to modify Seffernick to include a piezo-electric material or a suppression module.

Withdrawal of the 103 rejection is respectfully requested.

A notice of allowance is respectfully requested.

Respectfully submitted,



5 Mark P. Bourgeois  
Reg. No. 37,782  
(574) 293-7511